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RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAQUES FAGOT

Appeal 2007-2403
Application 10/072,429
Technology Center 3700

Oral Hearing Held: November 14, 2007

Before WILLIAM F. PATE, III, MURRIEL CRAWFORD, JOSEPH A.
FISCHETTI, Administrative Patent Judges

ON BEHALF OF THE APPELLANT:

ROGER W. PARKHURST, ESQUIRE
Steptoe & Johnson, LLP
1330 Connecticut Avenue, NW
Washington, DC 20036

The above-entitled matter came on for hearing on Wednesday, November
14, 2007, commencing at 10:01 a.m., at The U.S. Patent and Trademark
Office, 600 Dulany Street, Alexandria, Virginia, before Deborah Rinaldo,
RPR, Notary Public.

1 PROCEEDINGS
2

3 JUDGE PATE: This is an oral hearing pursuant to 37 CFR 41.47.
4We are in hearing room B on November 14, 2007. The judges are Judges
5Pate presiding with Judge Crawford and Judge Fischetti. We're going to do
6calendar numbers 31 and 32.

7 Good morning, Mr. Parkhurst. We've had a chance to go over your
8case beforehand and so we're up to speed on it and we're ready to hear your
9arguments.

10 MR. PARKHURST: Good morning. Thank you very much, Your
11Honor.

12 May it please the Board, appellants here appeal claims 1, 7, 8, 11, 12,
1315 and 16, as you've probably seen in the application that's on appeal.

14 The subject matter of this appeal is a set of golf clubs. And I have
15actually a sample that will illustrate if the Board would like to see a single
16club head that's relevant to this appeal. And then I would like to go over
17with you very briefly the subject matter of some of the elements of the
18claims. I can pass this up to you if would like.

19 JUDGE PATE: You may approach.

20 MR. PARKHURST: Thank you. Understand that this is only one
21sample of the type of structure of each club head in the set. And looking at
22the drawings of this application, for example, figure 9 which I've enlarged
23here and is the back view of the club head that you have there as a sample,
24I'm going to refer to a few of the elements in the claim.

25 The claim starts with the words "a set of golf club irons." As you can
26see from the sample, these are iron-type golf clubs or golf club heads.

1 Then the next portion perhaps half of the language of the claim
2 basically recites the fact that the weighting of the club head is so-called
3 perimeter weighted. In other words, this is a so-called perimeter weighted
4 style club head that has a lot of the weight near the perimeter of the backside
5 of the club head and has a cavity in the middle.

6 If any of you are golfers, you may recognize this as what's today
7 known as a cavity back or a perimeter weighted style club head.

8 Then moving on to the elements of the claim that really are the things
9 that are inventive here, the claim recites that there is at least one recess in the
10 upper wall. That's what is shown here in the upper wall, the recesses that are
11 also shown in the sample.

12 And these recesses open onto the rear face, in other words, rearwardly
13 in this upper wall. And they elongate in the main direction of that upper
14 wall, as you can see here in the figure from the case and in the sample.

15 Most specifically, the claim language says that the volume of these
16 recesses varies from club to club in the set so that the center of gravity of
17 each club head in the set varies in distance from the upper face, which is the
18 top of the club head, essentially varies vertically. The location of the center
19 of gravity varies vertically.

20 So that's the subject matter that's claimed in the independent claim.
21 And in a moment I'll get to a couple of the dependent claims which we want
22 to separately argue.

23 Now, the rejections that you have before you today are both section
24 103A rejections. The first of claims 1, 8, 11, 12 and 16 over the Peters and
25 Besnard references. And the second, claims 7 and 15, both dependent
26 claims over Peters and Besnard further in view of the Japanese reference and

1the Fenton patent. For today's hearing I think we'll concentrate primarily on
2Peters and Besnard.

3 Let's take Besnard first. When you look at the Besnard reference, I'm
4going to show you an enlargement of fig 9 of that reference here. Besnard
5does show recesses in what I call the top rail. And it shows multiple
6recesses. But Besnard does not show or suggest varying the volume of such
7recesses from club to club in the set of clubs. Besnard is essentially the
8design of a single club.

9 And you will also find in Besnard the disclosure that we quote at page
108 of our main brief. And I'm going to again quote some of that to you.

11 They say the upper perimeter portion of the peripheral belt -- they use
12the phrase "peripheral belt" for what I have been saying peripheral weighted.
13I think it's the same thing -- includes an elongate recess with a volume that
14increases in the direction of the toe.

15 As you can see here, the volume of their recess or recesses increases
16toward -- this is the toe end of the club. In the vernacular, in the golf
17business, the toe is the outer end. The heel is the end near the hosel and
18shaft.

19 They go on to say the position of the center of gravity can be adjusted
20precisely by providing a gradual lightening of the upper portion of the
21peripheral edge toward the toe.

22 That's what we see here when they decrease the volume of that upper
23edge with the result of displacing the center of gravity towards the bottom
24and heel of the club head.

25 Now, I have here a copy of fig 9 of the Besnard patent. If you look at
26fig 6, they actually show the center of gravity down in this region here.

1Whereas, in most clubs you might expect the center of gravity to be nearer
2the center, they say face center, FC, in Besnard.

3 You might expect the center of gravity to be somewhere in the center
4here. They show it because of this structure to be way back here, far back to
5the heel and somewhat downward.

6 But as I said earlier, Besnard does not disclose varying. These sort of
7recesses does not disclose changing their volume, changing their number
8from club to club in the set.

9 Having said that, let's now turn our attention to Peters. As you may
10have seen in the record and in our briefs, Peters, frankly, is admittedly not
11disclosing many elements of the independent claim, let alone dependent
12claims in applicant's case. If you look at page 6 of our main brief, page 3 of
13our reply brief, you see a list of specific elements that are not disclosed in
14Peters.

15 But perhaps most importantly, Peters in no way shows a structure in
16which the structure of the top rail is in any way modified from that of a
17standard perimeter weighted club.

18 Rather, the entire disclosure of Peters is devoted to increasing the
19weight of some bottom portion of the club head using the model you have in
20front of you, the sole portion, the bottom portion, and in no way is in any
21way creating recesses or in any way modifying this rail which looks flat,
22more like this, without recesses.

23 Perhaps the way in which the Peters disclosure is applied by the
24examiner below is epitomized by a statement at page 5 of the examiner's
25action -- I'm sorry, examiner's answer which I would like to discuss with
26you.

1 There, and I quote, the answer says, Peters does not specifically state
2that adding additional recesses of additional volume of recesses with weight
3inserts, as shown between figures 20 and 22, would change the center of
4gravity.

5 I would like to show you his figures 20 and 22 which are enlarged
6somewhat here.

7 As I understand that statement, he's saying that, yes, Peters shows
8putting additional weight in holes of some sort in the initial incomplete club
9head to form a complete club head and to thereby increase the weight by
10putting material in those holes that is of greater density than the material that
11the rest of the club head is made of.

12 But he says Peters does not say that by using this technique in fig 20
13rather than this technique in fig 22 that you necessarily change the location
14of the center of gravity. That's our understanding of what he's saying there.

15 He also then goes on to say, But a skilled artisan informing a set of
16irons with different centers of gravity as shown in figs 30 and 31, which I
17show you here, I think he's referring primarily to fig 31 where he shows a
18graph showing the vertical position of center of gravity corresponding to
19various clubs, you know, the irons are numbered from one up to nine
20basically.

21 These days you hardly see them below four, but that's the way it has
22been historically.

23 Getting back to his language, the examiner says -- he argues that
24artisans skilled in forming a set of irons with different centers of gravities, as
25shown in figs 30 and 31, would have selected a suitable way to adjust weight
26distribution in the vertical direction in which using additional recesses of the

1same volume with weight inserts between irons in a set are included.

2 Well, it seems to us, frankly, that he is reading the claimed invention
3into the prior art where it's not there. Peters simply says nothing more than
4put weight in the bottom of the club head without modifying the top of the
5club head to reduce the level of the center of gravity.

6 So what you are left with is Peters has nothing to do with the top rail
7in modifying it. You have Besnard that shows putting a groove in the top
8rail or multiple grooves which are wide at the toe for the purpose of moving
9the center of gravity primarily toward the heel and, yes, somewhat
10downward.

11 But none of them talk about varying the volume of such a series of
12recesses or varying the number of recesses as recited in one of our dependent
13claims for the purpose of moving vertically the center of gravity.

14 I would like to just touch on briefly dependent claim 8 which has in it
15a range of relative volumes of the recesses to the total volume of the head,
160.4 percent to 5 percent of the volume of the head.

17 That range is nowhere disclosed. No point in that range is disclosed
18or even suggested in any of the prior art in this record.

19 JUDGE PATE: Let me ask you a question about column 4 in
20Besnard. Along about line 25 he talks about the amount of material he's
21removing there and he says it's from three grams to 15 grams for a total head
22mass on the order of 230 grams to 300 grams.

23 The way I read it would be if you remove three grams from a 300-
24gram club, that would be 1 percent, right? Am I missing something there?

25 MR. PARKHURST: If your math is right, that would seem to be
26right, assuming it's a uniform density material.

1 JUDGE PATE: I see.

2 MR. PARKHURST: I have not quite found that quote, but I hear you.

3 And the other dependent claims that I noted in passing already,
4dependent claim 11 recites the limitation that the volume of all the recesses
5decreases from the long irons to the short irons.

6 And claim 12, dependent claim 12 wherein the number of recesses
7decreases from the long irons to the short irons, those concepts are nowhere
8in any of these references.

9 And incidentally, if you think about what both of those claims say,
10they are actually talking about increasing the height of the center of gravity
11in the long irons rather than decreasing it, which is the objective in Peters.

12 As a final comment, we feel that the weakness of the rejection is sort
13of epitomized by the fact that the examiner had to cite still a further
14reference in his reply brief, in his examiner's answer.

15 We think that reference -- I think it's Toulon -- either should be
16dismissed as unnecessarily late. Or if you really look at the substance, it
17doesn't add any more to the picture of the prior art than the fundamental
18references that we've discussed here today.

19 So applicant's position, appellant's position is that neither one of the
20primary references discloses and teaches something that would have led one
21of ordinary skill in the art to the specific structure which is narrowly claimed
22and that the 103 rejections of those claims should be reversed and those
23claims should be allowed.

24 JUDGE PATE: We have no more questions. So I think we'll take this
25case under advisement. Thank you for your presentation.

26 MR. PARKHURST: Thank you, Your Honors.

29Appeal 2007-2403

30Application 10/072,429

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1 (Whereupon, the proceedings at 10:16 a.m. were concluded.)